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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,382	05/11/2006	Amar Amar Mavinkurve	NL031373US1	8193

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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1796

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05/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,382	Applicant(s) MAVINKURVE ET AL.	
	Examiner Kuo-Liang Peng	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/11/06 Prel. Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/11/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' preliminary amendment under 37 C.F.R. 1.115 filed May 11, 2006 is acknowledged. Claims 4-10, 12-13 and 15-17 are amended. Now, Claims 1-17 are pending.

Claim Objections

2. Claims 1-17 are objected to because of the following informalities:

In Claims 1-17, Applicants are advised to replace "characterized in that" with -- wherein --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1 (line 1), should “Compound” be -- A composition -- because a “compound” conventionally refers to a single component?

In Claims 2-8 (line 1), should “Compound” be -- The composition --.

In Claims 5 (line 2), 8 (line 2), 10 (lines 3 and 4), 13 (line 4) and 14 (line 2), should “compound” be -- composition --?

In Claims 9 (lines 1-2), 10 (line 1) and 13 (line 2), should “a compound” be -- the composition --?

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present

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instance, Claim 8 recites the broad recitation “additives” (line 2), and the claim also recites “preferably a surfactant, a fragrance and a preservative” (line 3) which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 6-9 and 13-16 are rejected under 35 U.S.C. 102(a),(e) as being anticipated by Binder (US 6 582 476).

Binder discloses the claimed composition for improving the wrinkle resistance in fabrics. (col. 2, lines 6-35 and Example)

7. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bindl (US 5 399 652).

Bindl discloses a composition for treating textile, which comprises A) an organopolysiloxane containing amino groups and B) a crosslinking agent such as alkoxysilanes, etc. A catalyst and additives can be employed. (col. 1, lines 5-10, col. 2, lines 23-32, col. 2, line 43 to col. 3, line 29, col. 4, lines 61 to 68, col. 7, line 59 to col. 8, line 4, col. 8, lines 14-38, col. 11, lines 25-33 and 58-68 and Examples) The amount of the organopolysiloxane is exemplified in Examples. The composition can be in the form of an emulsion that should contain a surfactant as emulsifier. (col. 11, lines 58-68) The preamble “for improving the wrinkle resistance” or “[w]rinkle reducing active substance” are merely intended uses, and do not carry any weight of patentability. See MPEP 2111.02. Notably, for treating textile, the composition should clearly be retain in an container having an outlet so that the composition can be let out of the container and applied on to a fabric.

8. Claims 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Capua (WO 00 27977).

Capua discloses the claimed device. (page 31, lines 15-26 and Examples 8-10)

9. Claims 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Altmann (EP 1 201 817).

Altmann discloses the claimed device. (page 9, lines 31-32)

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bindl.

Bindl discloses a composition for treating textile, *supra*, which is incorporated herein by reference.

For Claim 11, Bindl is silent on separating the crosslinking agent from the polyorganosiloxane. However, Examiner takes Official notice that it is well within

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the skill of one of ordinary skill in the art to put these two components in separate containers before use. The motivation is to prolong the shelf-life of the composition. For Claims 16-17, Bindl is silent on the specific order of steps set forth in the instant claims. However, selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946)

12. Claims 13-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bindl.

For Claim 13, Bindl discloses a composition for treating textile, *supra*, which is incorporated herein by reference. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Bindl further demonstrates a method of using the composition in examples. Especially, the treated fabric is **compressed**. As such, Examiner has reasonable basis to believe that the wrinkles present, if any, should be removed. For Claim 14, the application of the composition can be realized by methods such

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as dipping, spreading, spraying, etc. (col. 12, lines 1-8) The fabric can be dipped in a container that holds the composition, and tested in accordance to DIN 53890 (i.e., in laboratory scale). (col. 16, lines 45-48) Therefore, Examiner has reasonable basis to believe the container is in a size of laboratory scale, which should broadly read on a domestic appliance. For Claim 15, the apparatus in laboratory scale for the foregoing compressing step indeed broadly reads on an iron.

13. The "X" reference cited in the international search report is not relied upon because of the following reason:

WO 01 44426 is not relied upon because the U.S. equivalent, US 6 582 476, has been applied.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
May 6, 2009

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796